## REMARKS

Applicants thank the Examiner for the thorough examination given the present application.

*Status of the Claims*

Claims 7-9, 11-12, and 15 are pending in the above-identified application. Support for the recitations in amended claim 7 can be found in the present specification, *inter alia*, at page 42 (Example 1) as well as in claim 10. As such, claim 10 is cancelled herein. Thus, no new matter has been added. Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

*Issues under 35 U.S.C. § 112, first paragraph*

Claims 7-12 and 15 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (page 2 of the outstanding Office Action). Specifically, the Examiner states that the phrase "the purification by distillation is carried out in a single pass" in claim 7 lacks support in the present specification. Applicants respectfully traverse.

Claim 7 is amended herein to delete the phrase "in a single pass." Thus, Applicants respectfully request that the rejection be withdrawn.

This limitation was added in order to overcome a rejection based on Kumabe et al. '070 (US 6,201,070), which discloses multiple passes through a wiped-film evaporator, one of which occurs at 180°C and **0.1-0.15 mmHg** to obtain the desired product as a **residue** (col. 13, lines 50-52). In stark contrast, amended claim 7 recites **a higher pressure, 4 to 50 Torr**. In addition, in the present invention, the solution having 5.5% or less of the high-molecular-weight components was obtained as a **distillate**. Therefore, even in the absence of the phrase "in a single pass," obviousness based on Kumabe et al. '070 is rebutted.

***Issues under 35 U.S.C. § 103***

Claims 7-12 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Takai '618 (US 2003/0059618) in view of Ryan et al. '297 (US 5,880,297) (pages 2-5 of the outstanding Office Action). Applicants respectfully traverse, and reconsideration and withdrawal of the rejection are respectfully requested.

*Legal Standard for Determining Prima Facie Obviousness*

MPEP 2141 sets forth the guidelines in determining obviousness. First, the Examiner has to take into account the factual inquiries set forth in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which has provided the controlling framework for an obviousness analysis. The four *Graham* factors are:

(a) determining the scope and content of the prior art;

(b) ascertaining the differences between the prior art and the claims in issue;

(c) resolving the level of ordinary skill in the pertinent art; and

(d) evaluating any evidence of secondary considerations.

*Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

Second, the Examiner has to provide some rationale for determining obviousness. MPEP 2143 sets forth some rationales that were established in the recent decision of KSR International Co. v Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

As the MPEP directs, all claim limitations must be considered in view of the cited prior art in order to establish a *prima facie* case of obviousness. *See* MPEP 2143.03.

*Distinctions over the Cited References*

In the present invention, the high-molecular-weight components are removed by distilling the post-reaction solution with a wiped film evaporator at a heating temperature ranging from 180 to 350°C and at a pressure of 4 to 50 Torr. As the Examiner admits, Takai '618 fails to disclose this element. As such, the Examiner relies on Ryan et al. '297 to overcome this deficiency. However, Ryan et al. '297 do **not** disclose purification by distillation with a wiped film evaporator at a temperature of 180 to 350°C **nor** a pressure of 4 to 50 Torr.

Moreover, in the present invention, alicyclic epoxy compound is highly purified according to the process to obtain the composition of the compound, a color hue of which is 60 or less. On the other hand, Ryan et al. '297 do **not** disclose nor suggest that a color hue of the alicyclic epoxy compound is reduced by the process. Therefore, the wiped film evaporator of Ryan et al. '297 is not applicable to Takai '618.

As discussed above, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Therefore, obviousness based on Takai '618 and Ryan et al. '297 has been rebutted, and withdrawal of the rejection is respectfully requested.

***Obviousness-Type Double Patenting***

The Examiner has provisionally rejected claim 7 under the doctrine of obviousness-type double patenting over claim 20 of co-pending Application No. 11/792,782 (pages 5-7 of the outstanding Office Action).

Applicants note that the present application has an earlier filing date than the filing date of the '782 Application. As such, if a provisional obviousness-type double patenting rejection is the only rejection remaining, the Examiner should withdraw the obviousness-type double patenting rejection in the earlier filed application (in this case, the present application) thereby permitting that application to issue without need of a terminal disclaimer (MPEP 804(I)(B)(1)).

## CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants respectfully request that a timely Notice of Allowance issue for the present case clearly indicating that each of claims 7-9, 11-12, and 15 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By _____

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